

REMARKS

CLAIM STATUS

Claims 1-17, 33, and 34 remain pending in this application.

SUMMARY OF THE OFFICE ACTION

The outstanding Action is a final Action that again acknowledges the claim for foreign priority and the receipt of the priority documents as well as acknowledging consideration of the reference filed with the Information Disclosure Statements of August 5, 2009.

In addition to the above-noted acknowledgements, the outstanding Action presents various prior art based rejections as to claims 1-17, 33, and 34 that are discussed in detail below.

IMPROPER REFERENCE CITATION

At the outset it is noted that U.S. Patent No. 6, 925,052 to Reynolds et al. (that is relied on to reject claims 33 and 34) has not been properly cited in accordance with 37 C.F.R. §1.104(d) as the "dates" of Reynolds were not cited by the Examiner contrary to the requirements of this Rule. Also, contrary to MPEP § 707.05(e), Reynolds et al. was not cited on the "Notice of References Cited" form PTO-892. Compliance with 37 C.F.R. §1.104(d) and MPEP § 707.05(e) is respectfully requested.

REJECTION OF CLAIMS 1-4, 7, 8, and 13-15 UNDER 35 U.S.C. §102

Item 3 on page 4 of the outstanding Action presents the above-noted rejection of claims 1-4, 7, 8, and 13-15 under 35 U.S.C. §102(b) as being allegedly anticipated by Hayton et al. (U.S. Patent Application Publication No. 2002/0120679, hereinafter "Hayton"). This rejection is traversed.

Turning to independent claim 1 it is again noted that this claim requires, *inter alia*, "an application managing unit that analyzes application data to determine a connector that specifies information indicating a function required for executing said application" (emphasis added). There is no teaching or suggestion in Hayton of any analysis of application data to determine anything, much less the independent claim 1 required determination of "a

connector that specifies information indicating a function required for executing said application.” As noted in relied upon paragraph [0050] of Hayton (at lines 11-13 of this paragraph), the property connector API 22 “resides” on a computing device, there is no analysis of any application data taught or suggested here to determine a connector, much less one that **“specifies information indicating a function required for executing said application.”**

In this last regard, the relied upon paragraph [0050] of Hayton teaches (at lines 4-7 of this paragraph) that “property connector API 22, and thus the client portion 22a and the server portion 22b, **is a process that is independent of the application 26 (i.e., not a part of nor generated from the application 26)** (emphasis added).

Thus, it is completely contrary to the teachings of paragraph [0050] of Hayton to suggest that this paragraph teaches the claim 1 required “application managing unit that **analyzes application data to determine a connector that specifies information indicating a function required for executing said application**” (emphasis added). Further in this regard, lines 13-17 of paragraph [0050] of Hayton only teaches that the connector API 22 provided on power-up or upon an authorized user log-in and that:

[t]he computing device can initiate execution of the property connector API 22 when the computing device downloads a page 42 containing UI elements 46 associated with property paths.

A complete reading of lines 11-20 of paragraph [0050] of Hayton reveals that the teachings here relate to various possible ways of initiating execution of API 22 that is resident on the computing device, not the alleged disclosure “that the computing device will execute a connector that corresponds to the application chosen for execution by a user.” Furthermore, even if it could be accurately stated that lines 13-17 of paragraph [0050] of Hayton “discloses that the computing device will execute a connector that corresponds to the application chosen for execution by a user,” which its clearly not the case, this misrepresentation of the actual disclosure of lines 13-17 of paragraph [0050] of Hayton does not anticipate the subject matter of claim 1 because it does not teach or suggest any “analysis” of any “application data” as required by claim 1.

Further, there is no teaching or suggestion to be found in relied upon lines 3-7 of paragraph [0017] of Hayton that is relevant to the further requirement of claim 1 for “a connector

obtaining unit responsive to the application management unit determination of the connector so as to obtain the connector" (emphasis added). In this respect, lines 3-7 of paragraph [0017] of Hayton are concerned with the components of the application and possible properties and property identifiers that identify these application components. The application, its components and property identifiers are, however, independent of the property connector API 22 as noted at lines 4-7 of paragraph [0050] of Hayton. Also, the suggested identification by the property connector module of lines 6-7 of paragraph [0017] does not respond to any connector determination or obtain any connector, it instead will "identify an association between the element of the user-interface and a property path, the property path including a concatenation of a plurality of identifiers, the concatenation of identifiers defining a path through the components of the application to a property at the end of the concatenation, and to map the property path to a current state of the property at the end of the path defined by the concatenation of identifiers, thereby associating the element of the user-interface with the current state of that property."

Also missing from Hayton is any teaching or suggestion of the claim 1 recited "function utilizing unit accessing a location of said function based on access information relating to the location described in information contained by said connector, and utilizing said function specified by said connector" (emphasis added). In this regard, relied upon lines 1-3 in paragraph [0080] of Hayton do not teach "accessing the page interface" as alleged. Instead, the teaching here is that page interface 112 will access the client node 64 that stores "the property file containing property paths," which relate to "the types of application components 34 that the application 26 creates and the type of properties 38 that each of the type of application components 34 contain." Once again, there is no reasonable correlation between the limitation specified by claim 1 and the relied upon disclosure of Hayton.

It is well established that a valid *prima facie* case of anticipation requires that all claim limitations must be properly considered and then demonstrated to be expressly or inherently described in a single prior art reference. The proper consideration of claim limitations is further well understood to require a full and factually based analysis thereof. In this regard, the PTO reviewing court has emphasized that conclusory findings that omit analysis as to the actual claim

limitations are improper in *Gechter v. Davidson* 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

For example, the [PTO] does not separately construe the term "agent status messages" before finding that [the reference] discloses just such "agent status messages."

To whatever extent that the Examiner may be ignoring the functions that the units of claim 1 are recited to perform, this is also clear error. *See In re Angstadt*, 190 USPQ 214, 217 (CCPA 1976) as follows:

We note at the outset that the claim limitation "to form * * * hydroperoxides" must be given effect since we *must* give effect to *all* claim limitations. *See In re Geerdes*, 491 F.2d 1260, 180 USPQ 789 (CCPA 1974); *In re Wilder*, 57 CCPA 1314, 429 F.2d 447, 166 USPQ 545 (1970).

Also note *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) in which the court held that functional limitations such as "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly."

Therefore, Hayton clearly does not expressly or inherently teach or suggest each and every element of previously presented independent claim 1. Accordingly, reconsideration and withdrawal of the improper rejection of independent claim 1 as being allegedly anticipated by Hayton is respectfully requested.

Furthermore, as claims 2-4, 7, 8, and 13-15 all depend either directly or indirectly from independent claim 1, these dependent claims are respectfully submitted to be improperly rejected as being anticipated by Hayton for at least the same reason as noted above as to parent independent claim 1. Accordingly, the withdrawal of the improper rejection of dependent claims 2-4, 7, 8, and 13-15 as being allegedly anticipated by Hayton is also respectfully requested.

REJECTIONS OF CLAIMS 5, 6, 9-12, 16, AND 17 UNDER 35 U.S.C. §103(a)

The outstanding Action further sets forth a rejection of dependent claim 5 under U.S.C. §103(a) as being unpatentable over Hayton in view of Braithwaite et al. (U.S. Patent Application Publication No. 2004/0193893, hereinafter "Braithwaite"), a rejection of dependent claim 6 under 35 U.S.C. §103(a) as being unpatentable over Hayton in view of Braithwaite in further

view of Chang et al. (U.S. Patent Application Publication No. 2002/0062397, hereinafter "Chang"), a rejection of dependent claim 9 under 35 U.S.C. §103(a) unpatentable over Hayton in view of Ney et al. (U.S. Patent No. 4,653,838, hereinafter "Ney"), a rejection of dependent claim 10 under 35 U.S.C. §103(a) as being unpatentable over Hayton in view of Jarvensivu (U.S. Patent Application Publication No. 2002/0188736), a rejection of dependent claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Hayton in view of Jarvensivu in further view of Tanaka (U.S. Patent No. 5,845,069), and a rejection of claims 16 and 17 under 35 U.S.C. §103(a) unpatentable over Hayton in view of Thompson (U.S. Patent No. 5,465,401). These rejections of claims all ultimately dependent on claim 1 are traversed.

First, it is noted that Braithwaite, Chang, Ney, Jarvensivu, Tanaka, and Thompson are cited as to the subject matter added by the particular dependent claim they are added to Hayton to reject. It is further noted that these references considered alone or together do not cure the deficiencies noted above as to the reliance on Hayton to reject base independent claim 1. Accordingly, dependent claims 5, 6, 9-12, 16, and 17 patentably define over the applied references for at least the same reason that parent independent claim 1 patentably defines over Hayton and the withdrawal of these rejections of dependent claims 5, 6, 9-12, 16, and 17 under 35 U.S.C. §103(a) is respectfully requested.

In addition, it is clear that the outstanding Action has improperly relied on each of the secondary references (Braithwaite, Chang, Ney, Jarvensivu, Tanaka, and Thompson) by extracting only partial teachings from each of these references. This alone violates precedent. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[reference] statements cannot be viewed in the abstract" because "they must be considered in the context of the teaching of the entire reference."). This is not new law, note *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) requiring "a fair reading of the prior art reference as a whole." Also note *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) that requires that one "must consider the entirety of the disclosure made by the references."

Besides erroneously taking partial reference teachings out of context, the outstanding Action then further errs by improperly taking these extracted partial teachings and expanding them to create speculative teachings of far greater scope than any actual teaching of any of these

references properly considered in actual context. However, such expansion of reference teachings using unfounded assumptions and/or speculation cannot be substituted for actual reference teachings. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not ... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

For example, paragraph [0050] of Braithwaite (either at relied on lines 7-11 or at relied on lines 8-13) clearly does not disclose “the general concepts wherein said function utilizing unit converts a result obtained from said function based on said data conversion information.” Instead of teaching any general concepts at all, paragraph [0050] of Braithwaite teaches the specifics of transferring an existing user biometric template created for enrollment with one application from the enrollment database for that application to another enrollment database for a different application and in a different format as follows:

As shown in FIG. 3, at step 304 user 1 requests and authorizes the transfer of user 1's existing enrollment template, created for application A, to the enrollment database for application B. At step 408 a Template Authority submits a (preferably) authenticated request to application A database, DB_A for user 1's enrolled template, that exists in the database DB_A in a format consistent with application A. Upon receiving user 1's template, at step 312 the Template Authority retrieves application A's transformation function F_A (e.g. from archival storage), inverts it, and then converts the result at step 316 to Application B's format by applying the Application B format F_B . According to this aspect of the invention, an application transformation is not exposed to another application, and yet users may be able to use their existing enrollments for new applications without incurring the cost and inconvenience of re-enrolling their biometric for each new application.

While the “Template Authority” may retrieve a transformation function from one database, invert this retrieved transformation function and then convert the inverted result to the required format for the second database, this inversion-conversion of a transformation function is not a teaching of a general concept of converting “a result obtained from said function based on said data conversion information” as incorrectly stated. In this last regard, and as noted above, *In re Kotzab, supra*, notes that “[reference] statements cannot be viewed in the abstract” because “they must be considered in the context of the teaching of the entire reference.” Further note *In*

re Wesslau, 147 USPQ 391, 393 (CCPA 1965) establishing that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

In addition to improperly extracting partial reference teachings and then improperly expanding such extracted partial teachings into speculatively based generalizations, it is noted that the outstanding Action has clearly misinterpreted the Ney teachings of storage of an electrical circuit board hardware "connector" as somehow applicable to the Hayton "property connector" that "represents a property 38 of an application component 34 within an application 26 as a property path," as explained in of paragraph [0052] of Hayton. Clearly, teachings as to the Ney circuit board "connectors" are not relevant to either the Hayton taught "connector" or the "connector" of this application.

Thus, not only do these 35 U.S.C. §103(a) rejections of dependent claim 5 (as being unpatentable over Hayton in view of Braithwaite), dependent claim 6 (as being unpatentable over Hayton in view of Braithwaite in further view of Chang), dependent claim 9 (as being unpatentable over Hayton in view of Ney), dependent claim 10 (as being unpatentable over Hayton in view of Jarvisv), dependent claims 11 and 12 (as being unpatentable over Hayton in view of Jarvisv in further view of Tanaka, and dependent claims 16 and 17 (being unpatentable over Hayton in view of Thompson) fail to establish a valid *prima facie* case of obviousness as to the subject matter of base independent claim 1, they also fail because they are clearly hindsight reconstructions that improperly rely on extracting isolated incomplete reference teachings that are then improperly subjectively expanded into abstract principles to address the claim limitations with total disregard as to the entirety of the actual reference teaching.

REJECTION OF CLAIMS 33 and 34 UNDER 35 U.S.C. §102

Item 6 on page 5 of the outstanding Action presents the above-noted rejection of claims 33 and 34 under 35 U.S.C. §102(e) as being allegedly anticipated by Reynolds et al. (U.S. Patent No. 6,925,052, hereinafter "Reynolds"). This rejection is traversed

It is again noted to be well established that a valid *prima facie* case of anticipation requires that all claim limitations must be properly considered and then demonstrated to be expressly or inherently described in a single prior art reference relative to the above noted *Gechter v. Davidson* decision.

In this regard, base claim 33 first recites a limitation requiring “an application managing unit that analyzes application data to determine a required connector that includes information needed to identify a required function needed to execute said application.” The outstanding Action does not attempt to “construe” this language by providing any express interpretation as to the meaning thereof. Instead, it is simply repeated in the first paragraph at the top of page 6 of the outstanding Action with the cryptic parenthetical expression “see col. 4, lines 40-44.” However, this portion of Reynolds simply describes physical hardware connectors that may provide “inputs, outputs or both.” It further notes that in “a telecommunications network probe application, the transport of data in the backplane will generally be inward, from the external connectors to the processing modules,” but this does not teach or suggest that these external connectors are the result of any analysis of anything by anything. Instead, all that appears to be suggested here are typical electrical connector elements as more fully treated at col. 21, lines 1-11 as follows:

Referring also to FIGS. 15B and 15C, there are ten card slots labelled F1-F10 on the front side of the backplane 190. There are two shallow slots B1 and B2 to the rear of the backplane 190, back-to back with F9 and F10 respectively. The front slot dimensions correspond to those of the cPCI standard, which also defines up to five standard electrical connectors referred to generally as J1 to J5, as marked in FIGS. 15B and 15C. It will be known to the skilled reader that connectors J1 and J2 have 110 pins each, and the functions of these are specified in the cPCI standard (version PICMG 2.0 R2.1 (May 1st 1998)).

While Reynolds also describes other physical “connectors,” it is clear that no “connectors” are taught to result from the claim 33 required “application managing unit that analyzes application data to determine a required connector that includes information needed to identify a required function needed to execute said application.”

The claim 33 limitation requiring a “connector managing unit responsive to the application management unit determination of the required connector so as to obtain the required

connector and to analyze it to determine the required function and location of the required function” is given a similar improper treatment as to simply repeating the limitation and including a cryptic reference to a completely unrelated disclosure in Reynolds as to col. 5, lines 55-58. In this respect the possibility noted as to “a dedicated location for a management module for selective routing of the LAN or other output communications from the external connectors to the processing modules” includes no suggestion of this “management module” responding to anything, much less that it responds to the claimed “application management unit determination of the required connector” or that it performs an analysis of any thing, much less that it will analyze the required connector “to determine the required function and location of the required function.”

Similarly, the teachings of Reynolds found at the cited location of col. 7, lines 47-51, that deal with a possible “management module location” have no reasonable applicability to the claim 33 recited “external function management unit” and the function it must perform. Likewise, the teachings of Reynolds found at the cited location of col. 25, lines 30-34, that deal with differences in usage of “cPCI connector pins” has no reasonable applicability to the claim 33 recited “internal function management unit” or its recited function.

To whatever extent that the Examiner may be again ignoring the functions that the units of claim 33 are recited to perform, this is again noted to be clear error. See the above noted *Angstadt, Geerdes, Wilder, and Venezia* decisions

Therefore, Reynolds clearly does not disclose each and every element of independent claim 33 either expressly or under the doctrine of inherency. Accordingly, reconsideration and withdrawal of the improper rejection of independent claim 33 as being allegedly anticipated by Reynolds is respectfully requested.

Furthermore, as claim 34 depends directly from independent claim 33, this dependent claims is respectfully submitted to be improperly rejected as being anticipated by Reynolds for at least the same reason as noted above as to parent independent claim 33. Accordingly, the withdrawal of the improper rejection of dependent claim 34 as being allegedly anticipated by Reynolds is also respectfully requested.

CONCLUSION

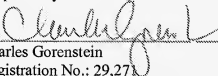
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By



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